

REMARKS

As of the date of the Office Action mailed November 3, 2009 (“Office Action”), Claims 79-89, 92 and 93 were pending in this application. Claims 78-89, 92 and 93 have been cancelled in the present amendment and new claims 94-106 have been added.

Section 103 Rejections

In the Office Action, claims 79-89, 92 and 93 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,588,732 to Caceres et al. (“Caceres”) in view of U.S. Patent Application Publication 2001/0047741 to Gleeson et al (“Gleeson”) and further in view of U.S. Pat. No. 3,801,072 to Newberry, Jr. (“Newberry”). Applicants respectfully traverse these rejections. With respect to the rejections as applied to claims 79-89 and 92-93, these claims have been cancelled in the present amendment and the rejection is rendered moot.

In an effort to advance the case to allowance, Applicants discuss briefly the principal reference cited by the Examiner, Caceres. Caceres is directed to a fiberglass fencing system made of fiberglass components formed by pultrusion (combining a resin with reinforcing material, and pulling the combination through a die). See Col. 3, lines 6-8. In order to provide a textured surface, Caceres teaches that a layer of resin impregnated reinforcing fiber mesh is placed on each of the picket faces prior to drawing it through the shaping die (see Col. 3, lines 29-32).

In the Office Action, the Examiner acknowledges that Caceres fails to disclose elongate members comprising fiber cement, or fiber cement incorporating a low-density additive such as microspheres or volcanic ash or moisture resistant cellulose fibers. However, the Examiner argues nonetheless that, in light of the single sentence in Gleeson regarding the formulation having applicability to building product applications including “fencing”, it would have been obvious to modify the Caceres fiberglass components with the fiber cement material taught by Gleeson, the Examiner relying on *In re Leshin*, 125 USPQ 416 (CCPA 1960) for the proposition that “the selection of a known material on the basis of its suitability for the intended use is a design consideration within the skill of the art”. Applicants respectfully disagree.

To begin with, there is no prior art reference that discloses all the variables recited in Applicants’ claims, in particular, a uniform repeating embossed pattern, provided on each of the front surface and the back surface of an elongated member comprising fiber cement, the pattern

being provided using a plurality of rollers, wherein each roller has a textured surface and is adapted to turn at a predetermined speed relative to the elongated member to achieve a high fidelity transfer of the pattern to the front surface and the back surface of the elongated member, and further, the pattern being formed of the same material as the elongated member.

In addition, *Leshin* is distinguishable from the present case. In *Leshin*, the court held that mere selection of known plastics to make a container-dispenser of a type made of plastic - the selection of the plastic being on the basis of suitability for the intended use, i.e., to hold contents - would have been obvious to one of ordinary skill in the art. See *Leshin*, 125 USPTO at 417-18. Unlike the facts in *Leshin*, however, Applicants did not select a “known material on the basis of its suitability for the intended use.” There is no disclosure or suggestion in the art of record of forming a high fidelity embossed pattern on multiple sides of a fiber cement article in accordance with Applicants’ claims.

For all the reasons set forth above, Applicants respectfully request withdrawal of the rejections under Section 103 and allowance of all pending claims.

CONCLUSION

In light of the amendments and remarks set forth above, Applicants respectfully submit that the Application is now in allowable form. Accordingly, Applicants respectfully request consideration and allowance of the currently pending claims. Applicants hereby submit payment in the amounts of \$810.00 for the RCE fee and \$1,110.00 for a three month extension of time fee. It is believed that no additional fees are due at this time. If this is incorrect, Applicants hereby authorize the Commissioner to charge any fees, other than issue fees, that may be required by this paper to Deposit Account No. 07-0153. The Examiner is respectfully requested to call Applicants’ Attorney for any reason that would advance the current application to issue.

Respectfully submitted,

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